



PATENT
Attorney Docket No. 266/106

In The United States Patent and Trademark Office

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In re Application of:

Inventor: Paul NAKANE

Application No: 09/920,785

Filed: August 1, 2001

For: RAPID ANTIBIOTIC
SUSCEPTIBILITY TEST

Group Art Unit: 1651

Examiner: Lilling, Herbert

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Date: September 11, 2002

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RESPONSE TO NON-FINAL OFFICE ACTION

Commissioner for Patents
Washington, D.C. 20231

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In response to the non-final Office Action dated July 11, 2002, in which the examiner issued a restriction requirement, please take the following actions and consider the remarks below.

Restriction requirement

The examiner has required that applicant elect from among four groups of inventions that the examiner is of the opinion constitute separate and distinct inventions. In addition, the examiner has required that the applicant elect one species for examination with the understanding that, if no generic claim is finally held to be

allowable, the claims may be restricted to the elected species. The examiner states that claims 17 and 18 are generic.

Applicant's response

Applicant elects Group I, claims 1 – 16, 21 and 22, drawn to a method for determining the susceptibility of bacterial cells to an antibiotic, classified in class 435, subclass 32. Applicant respectfully points out that, within this Group, claim 1 is generic, which the examiner did not note in the Office Action.

With regard to election of a species for examination, applicant elects, with traverse, one antibiotic, trimethoprim, spinal fluid as the bodily fluid from which the bacterial species is isolated and light microscopy as the method of observing the bacterial cells. The remainder of the species set forth by the examiner relate to non-elected Groups and therefore need not be considered.

Applicant traverses the species election in that applicant disagrees with the narrowing of the species to a specific bodily fluid and to a specific method of observation. The dependent claims distinguish between bodily fluids, tissue and feces as sources of the bacteria to be tested. Applicant submits that "bodily fluid" is a sufficiently defined species to allow examination without undue burden. Likewise, the claims distinguish between observation by the naked eye and observation by instrumental means. Limiting the elected Group to species in which observation is done with the naked eye should suffice as a species without the election of a particular way of observing with the naked eye. Thus, applicant respectfully requests that the species of Group I to be examined include trimethoprim and its effect on bacteria isolated from any bodily fluid and observation by any means employing the naked eye.

CONCLUSION

Applicant believes that, when the above election is entered, the elected claims are allowable and thus respectfully requests that they be passed to issue.

Applicant does not believe that any fee is due with this response. If this is incorrect, the commissioner is authorized to charge any amount due to Bingham McCutchen Deposit Account No. 50-1189, billing reference no. 24748-7238.

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Date: September 11, 2002

Respectfully submitted,

Bingham McCutchen LLP

By: 

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